

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:  
Andrew Michael Duggan et al.

Serial No.: 10/809,042

Confirmation No.: 5804

Filed: March 25, 2004

For: TUBING EXPANSION

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Group Art Unit: 3725

Examiner: Debra M. Wolfe

MAIL STOP AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

CERTIFICATE OF MAILING OR TRANSMISSION 37 CFR 1.8	
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<u>Oct 23, 2008</u> Date	<u>Planetta J. Clark</u> Signature

REMARKS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW

In conjunction with the Notice of Appeal filed herewith, Applicants request a Panel review of the Final Rejection in this matter. Although the remarks herein are focused on specific issues raised by the rejection, nothing in this paper is meant to limit the scope of any arguments, either factual or legal, that Applicants may later present in a full appeal brief.

## QUESTIONS FOR REVIEW

Applicants request a pre-appeal brief conference review to address the deficiency in the Examiner's anticipation and obviousness rejections. In a Final Office Action dated July 30, 2008, the Examiner finally rejected most of the pending claims under §102(e) or §103(a). Applicants respectfully submit that the Examiner has failed to properly establish the essential elements needed for an anticipation rejection and a *prima facie* rejection due to clear errors in the Examiner's rejections.

## REMARKS

- I. **Claims 1-3, 6-19, 22, 23, 25, 29-35, 42, 43, 49, 52, 53, 63-65, 98-100 are not anticipated by Metcalfe (US 6,543,552) and are allowable.**

In the Final Office Action, the Examiner rejected claims 1-3, 6-19, 22, 23, 25, 29-35, 42, 43, 49, 52, 53, 63-65, 98-100 under 35 U.S.C. § 102(e) as being anticipated by Metcalfe. The Examiner asserts that Metcalfe discloses an expansion device having expansion members adapted to expand a tubing by inducing a compressive yield and an expansion cone adapted to expand a tubing by inducing a hoop stress based upon a Figure generated by the Examiner as shown in the Office Action and also shown below as Figure A for convenience.

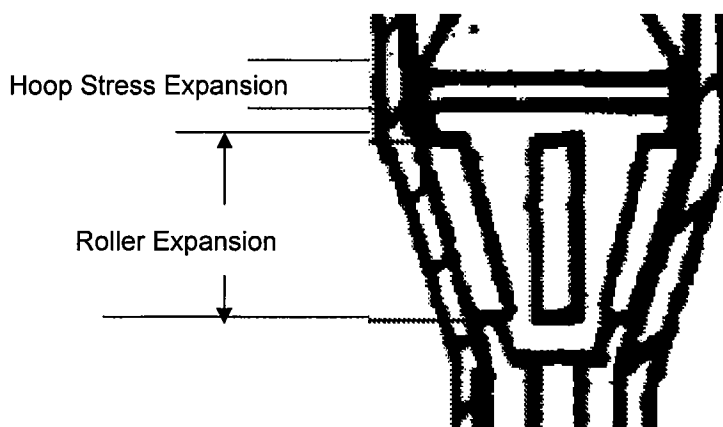


Figure A

However, Metcalfe fails to disclose each and every element as set forth in the claims. Metcalfe therefore cannot anticipate the claims.

According to MPEP 2131, to anticipate a claim, the reference must teach every element of the claim. Claims 1 and 100 include the limitation of at least one expansion member adapted to expand a tubing by inducing a hoop stress in the tubing and at least one further expansion member adapted to expand the tubing by inducing a compressive yield of the tubing. The Examiner incorrectly identifies a portion of an expander disclosed in *Metcalfe* as a "hoop stress expansion member." In particular, tubing shown in the Figure A above and also reproduced in the Office Action has a constant diameter both directly before and after the portion purported by the Examiner to be the hoop stress expansion member, such that no expansion by this portion is illustrated. Moreover, the specification of *Metcalfe* clearly states at column 5, line 65 through column 6, line 1, that "the first expander section rollers 38 move in rolling contact around the inner wall of the tubing 18, and expand the tubing to an intermediate diameter." Thus, the rollers produce the expansion and not the portion that trails the rollers. Column 3, lines 10-17, of *Metcalfe* states, in contrast to the expander shown, that "[o]ther (emphasis added) forms of expanders may be utilized, such as a fixed cone," which further evidences that the portion identified by the Examiner cannot be the hoop stress expansion member, as the Examiner alleges.

Therefore, *Metcalfe* fails to teach, show or suggest a device having "at least one expansion member adapted to expand a tubing by inducing a hoop stress in the tubing... and at least one further expansion member adapted to expand the tubing by inducing a compressive yield of the tubing, wherein... the device is arranged such that expansion of the tubing to a desired final diameter is carried out using the hoop stress inducing expansion member," as recited in claims 1 and 100. *Metcalfe* cannot anticipate or render obvious claim 1 or 100 or any claim dependent thereon. Accordingly, Applicants request withdrawal of the. § 102(e) rejection and allowance of claims 1-3, 6-19, 22, 23, 25, 29-35, 42, 43, 49, 52, 53, 63-65, and 98-100.

**II. Claim 44 is not rendered obvious by Metcalfe and Lauritzen (U.S. 6,722,441) and is allowable.**

The Examiner rejected claim 44 under 35 U.S.C. § 103(a) as being obvious over Metcalfe and Lauritzen (U.S. 6,722,441). The Examiner asserts that it would obvious to

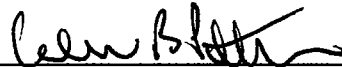
modify the compressive yield expansion members of Metcalf to be mounted on a spindle of Lauritzen in order to permit rotation about a rotational axis.

Applicants believe claim 44 is in condition for allowance for the same reasons stated above with respect to independent claim 1. Applicants respectfully request withdrawal of the § 103(a) rejection and allowance of claim 44.

### ***Conclusion***

Applicant believes that the foregoing discussion demonstrates the patentability of the present claims over the cited references. Accordingly, Applicant requests that the Panel vacate the rejections and remand the matter to the Examiner with instructions to allow the present claims.

Respectfully submitted,



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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) CRUI/0012	
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	First Named Inventor Andrew Michael Duggan et al.		
	Art Unit 3725	Examiner Debra M. Wolfe	
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>34,102</u> <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number _____</p> <p><u>William B. Patterson</u> Signature <u>William B. Patterson</u> Typed or printed name <u>(713) 623-4844</u> Telephone number <u>Oct 23 2008</u> Date</p> <p><input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted.</p>			

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